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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,071

05/11/2006

Martin Hirsch

4791-4012

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27123 7590 12/29/2008  
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EXAMINER

HEVEY, JOHN A

ART UNIT

PAPER NUMBER

1793

NOTIFICATION DATE

DELIVERY MODE

12/29/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com  
Shopkins@Morganfinnegan.com  
jmedina@Morganfinnegan.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/540,071	<b>Applicant(s)</b> HIRSCH ET AL.	
	<b>Examiner</b> JOHN A. HEVEY	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 17-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 11 and 15 is/are rejected.
- 7) ☒ Claim(s) 6, 8-10, 12-14, 16, 27 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Application***

Claims 1-16 and 27-28 are pending and presented for examination, claims 17-26 are withdrawn.

All previous rejections over Nuber et al. (WO 2004/056465) have been withdrawn in view of applicant submitted translation of foreign priority documents.

Obvious-type double patenting rejection over co-pending application 10/540438 has been withdrawn in view of applicant submitted terminal disclaimer filed 10/23/2008.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1793

4. Claims 1-5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/540376. Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclose a process of heating metal compounds in a fluidized bed process, wherein a gas is supplied from below via a gas supply tube at least partially surrounded by a stationary fluidized bed, comprise overlapping temperature ranges and the same particle Froude numbers. Claim 1 of the copending application does not disclose that the “gas flowing through the gas supply tube entrains solids from the fluidized bed into the mixing chamber when passing through the upper orifice region of the gas supply tube” however, the application clearly suggests this feature, and such a feature would necessarily follow from the disclosed process. Claim 1 of the copending application does not disclose that the “gas flowing through the gas supply tube entrains solids from the fluidized bed into the mixing chamber when passing through the upper orifice region of the gas supply tube” however, the application clearly suggests this feature, and such a feature would necessarily follow from the disclosed process. Furthermore, it would have been obvious to one of ordinary skill in the art to select a titanium containing compound as the metal compound required by the instant application, as the use of various metal containing compounds are linked by the need for heat treatment processes in the form of roasting or calcining.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 1793

5. Claims 1-5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/540435. Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclose a process of heating metal compounds in a fluidized bed process, wherein a gas is supplied from below via a gas supply tube at least partially surrounded by a stationary fluidized bed, comprise overlapping temperature ranges and the same particle Froude numbers. Claim 1 of the copending application does not disclose that the “gas flowing through the gas supply tube entrains solids from the fluidized bed into the mixing chamber when passing through the upper orifice region of the gas supply tube” however, the application clearly suggests this feature, and such a feature would necessarily follow from the disclosed process. Furthermore, it would have been obvious to one of ordinary skill in the art to select a metal compound as a fine-grained solid required by the copending application, and suggests such a selection in copending claim 6.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-5, 7, 11, and 15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 7, 11, and 12 of copending Application No. 10/540436. Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclose a process of heating metal compounds in a fluidized bed process, wherein a gas is

Art Unit: 1793

supplied from below via a gas supply tube at least partially surrounded by a stationary fluidized bed, comprise overlapping temperature ranges and the same particle Froude numbers. Claim 1 of the copending application does not disclose that the “gas flowing through the gas supply tube entrains solids from the fluidized bed into the mixing chamber when passing through the upper orifice region of the gas supply tube” however, the application clearly suggests this feature, and such a feature would necessarily follow from the disclosed process. Furthermore, it would have been obvious to one of ordinary skill in the art to select a metal compound as a fine-grained solid required by the copending application, and suggests such a selection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Allowable Subject Matter***

1. Claims 6, 8-10, 12-14, 16, and 27-28 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

2. Applicant's arguments, filed 10/23/2008, with respect to rejections over Schmidt in view of Hiltunen have been fully considered and are persuasive. The rejection of claims 1-5, 7, 9-12, 14-15, and 27 over Schmidt in view of Hiltunen, claims 13 and 28

Art Unit: 1793

over Schmidt in view of Hiltunen and Okuno, and claim 6 over Schmidt in view of Hiltunen and Misra have been withdrawn.

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN A. HEVEY whose telephone number is (571)270-3594. The examiner can normally be reached on Monday - Friday 8:00 AM to 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Ward can be reached on 571-272-1223. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1793

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. A. H./  
Examiner, Art Unit 1793

/Kevin P. Kerns/  
Primary Examiner, Art Unit 1793